



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Hoemann, M. Z. et al.

Examiner: Desai, R. J.

Application Serial No.: 10/722,114

Art Unit: 1625

Filed: November 25, 2003

Atty. Docket No.: SPV-048.02

Title: *4,4-Disubstituted Piperidines, and Methods of Use Thereof*

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the U. S. Postal Service as First Class Mail with sufficient postage on the date set forth below in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

8-26-04

By: _____

Date of Signature and Mail Deposit


John Barreto

RESPONSE TO RESTRICTION REQUIREMENT

Dear Examiner Desai:

In response to the Restriction Requirement in the above-identified application, mailed July 26, 2004, the Applicants respectfully elect without traverse **Invention I**, claim 1, drawn to a compound of formula A, wherein R₁ is aryl; R₂ is RO-alkyl, R₂N-alkyl, RS-alkyl, R₂N-cycloalkyl or RS-cycloalkyl; R₃ and R₄ are H, alkyl, F or -OR; and R₅ is a phenyl or thiophene.

Nevertheless, the Applicants respectfully assert that simultaneous examination of Invention I and Invention V would not place an undue burden on the Examiner because the Inventions are related as they share the structural features, differing in the nature of the substituent at R₃ and R₄. *See* MPEP § 803 ("If the search and examination of an entire application can be made without serious burden, the [E]xaminer must examine it on the merits, even though it includes claims to independent or distinct inventions."). Therefore, the

Applicants respectfully request that the Examiner modify the instant Restriction Requirement, examining Inventions I and V, i.e., all claims wherein R₁ is aryl; R₂ is RO-alkyl, R₂N-alkyl, RS-alkyl, R₂N-cycloalkyl or RS-cycloalkyl; R₃ and R₄ are H, alkyl, F -OR, *heteroaryl* or *heteroaralkyl*; and R₅ is a phenyl or thiophene.

Fees

The Applicants believe that no fees are due in connection with the filing of this Response. Nevertheless, the Commissioner is hereby authorized to charge any fees due in connection with the filing of this Response to our Deposit Account, **No. 06-1448**.

Respectfully submitted,
Foley Hoag LLP

By: 

Dana M. Gordon, PhD
Reg. No. 44,719
Attorney for Applicants

155 Seaport Boulevard
Boston, MA 02210

Telephone: (617) 832-1000
Telecopier: (617) 832-7000

Date: August 26, 2004